



(18)

FILED  
OCT 21 1944  
U.S. DISTRICT COURT  
DISTRICT OF MASSACHUSETTS  
BOSTON

Supreme Court of the United States

OCTOBER TERM, 1944

No. 10

MASSACHUSETTS RAIL & TRANSIT CO.

U. S. STEUBERT & COMPANY

Respondents

RESPONDENTS

U. S. STEUBERT & COMPANY

1944

1944



## TABLE OF CONTENTS.

	Page
Statement of the Case . . . . .	1
The Subject-Matter of the Patents . . . . .	3
Facts are Unusually Complex and Technical . . . . .	5
The Alleged Issues . . . . .	6
Summary of Argument . . . . .	8
ARGUMENT . . . . .	9
The Rule of the Bassick and Lincoln Cases Does Not Apply Here . . . . .	9
Hagen Made Improved Combinations . . . . .	12
Petitioner's Allegations of Conflict of Decisions Not Sup- ported by Cases . . . . .	16
The Decision of the Circuit Court of Appeals . . . . .	16
"Patentable Advance" . . . . .	18
The Traitel Case . . . . .	18
No Conflict of Authority . . . . .	19
Duration of Patent Terms Not Pertinent Here . . . . .	23
Conclusion . . . . .	24

## TABLE OF CASES CITED.

Anderson v. Collins, 122 F. 451, 458 . . . . .	19
Bassick Mfg. Co. v. R. M. Hollingshead Co., 298 U. S. 415 . . . . .	2
B. B. Chemical Co. v. Ellis, 86 L. Ed. 320 . . . . .	2
Busell v. Stevens, 137 U. S. 423 . . . . .	21
Byck, In re, 48 F. (2d) 665, 666 . . . . .	20
Calvert, In re, 97 F. (2d) 638 . . . . .	21
Cantrell v. Wallick, 117 U. S. 689, 694 . . . . .	19
Carlton, In re, 77 F. (2d) 363 . . . . .	21
Century Electric Co. v. Westinghouse, 191 F. 350, 352 . . . . .	19

	Page
Cohen, Ex parte, 52 USPQ 189 . . . . .	21
City of Milwaukee v. Activated Sludge Inc., 69 F. (2d) 577, 587 . . . . .	19
Davis et al., In re, 123 F. (2d) 651 . . . . .	21
General Tire & Rubber Co. v. Fisk Rubber Corp., 104 F. (2d) 740, 745 . . . . .	20
Kyrides, Ex parte, 48 USPQ 337 . . . . .	21
James, In re, 83 F. (2d) 313, 314 . . . . .	20
Land, In re, 109 F. (2d) 246, 250 . . . . .	20
Land, In re, 109 F. (2d) 251, 252 . . . . .	21
Lincoln Engr. Co. v. Stewart-Warner Corp., 303 U. S. 545, Lion Fastener, Inc. v. Hookless Fastener Co., 72 F. (2d) 985 . . . . .	2
McCarthy, Ex parte, 50 USPQ 480 . . . . .	21
Miller v. Eagle Mfg. Co., 151 U. S. 186, 198 . . . . .	7
Morton Salt Co. v. G. S. Suppiger Co., 86 L. Ed. 317 . . . . .	2
Neuberth, In re, 82 F. (2d) 718, 720 . . . . .	20
Peiler, In re, 56 F. (2d) 878, 880 . . . . .	20
Pyle National Co. et al. v. Lewin, 92 F. (2d) 678 . . . . .	19
Sandy MacGregor Co. v. Vaco Grip Co., 2 F. (2d) 655, 656 Seebach, In re, 88 F. (2d) 722, 724 . . . . .	19 20
Skinner Bros. Belting Co. v. Oil Well Imp. Co., 54 F. (2d) 896, 889 . . . . .	19
Suffolk Mfg. Co. v. Hayden, 3 Wall. 315, 318 . . . . .	19
The Barbed Wire Patent Case, 143 U. S. 275, 280 . . . . .	7, 19
Thomson Co. v. Ohio Brass Co., 80 F. 712 . . . . .	18
Thomson-Houston Co. v. Jeffrey Mfg. Co., 101 F. 121 . . . . .	22
Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co., 22 F. (2d) 259 . . . . .	3
Trico Products Corp. v. E. A. Laboratories, 71 F. (2d) 677 . . . . .	19
Underwood v. Gerber, 149 U. S. 224 . . . . .	21

In the  
**Supreme Court of the United States.**

---

OCTOBER TERM, 1941.

---

No. 968.

MASSACHUSETTS HAIR & FELT COMPANY,  
PETITIONER,

v.

B. F. STURTEVANT COMPANY,  
RESPONDENT.

---

**RESPONDENT'S BRIEF**

IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

---

**STATEMENT OF THE CASE.**

At the outset, and as often thereafter as possible throughout its petition and brief in support thereof, petitioner speaks of an "extension of monopoly".

The exclusive rights granted under a patent in a proper case are not rights that are taken away from the public; they are rights that never before existed. They are therefore to be distinguished from monopolies as that term is frequently used to describe the unlawful suppression of free trade and fair competition.

Unfortunately in some instances, attempts have been made to use patents to this same end. This Court has had cases before it in which it appreciated that the owner of a

patent was not content to exercise and enjoy the limited rights conferred by the patent grant but had attempted to extend those rights to unpatented things and thereby unjustly impose an illegal monopoly upon the public. The recent *Morton Salt* case<sup>1</sup> and the *B. B. Chemical* case<sup>2</sup> are examples of such unconscionable practice on the part of patentees. Other inventors, prior to the grant of a patent, seek claims for more than they have a right to claim as their inventions and, if successful in the Patent Office, then attempt to embrace within their apparent patent domain things which are actually free to the public to make, use and vend. Examples of that kind of unlawful monopolistic practice are found in the *Bassick* case<sup>3</sup> and in the *Lincoln* case<sup>4</sup> strongly relied upon by the petitioner here. In all such cases the patentees were infringing upon the rights of the public and the Court was justified in voiding or invalidating their patent rights.

Every inventor is not necessarily seeking "extension of monopoly" just because he has a patent and asks a Court to enjoin an infringer of his limited rights. But if he brings suit for infringement, the defending party will immediately cry "extension of monopoly" and if the patent contains claims for a "combination" the defendant will promptly assert that they are invalid under the rule of the *Bassick* and *Lincoln* cases. Such is the present situation.

There is here no conflict of decisions between Circuit Courts of Appeals. The two patents here in suit have not previously been litigated. Here no question of local law is involved and no question of federal law has been decided which has not been or which should be settled by this Court or which has been decided in a way probably in conflict with

---

<sup>1</sup> *Morton Salt Co. v. G. S. Suppiger Co.*, 86 L. Ed. 317.

<sup>2</sup> *B. B. Chemical Co. v. Ellis*, 86 L. Ed. 320.

<sup>3</sup> *Bassick Mfg. Co. v. R. M. Hollingshead Co.*, 298 U.S. 415.

<sup>4</sup> *Lincoln Engr. Co. v. Stewart-Warner Corp.*, 303 U.S. 545.

applicable decisions of this Court. The Circuit Court of Appeals has not so far departed from the accepted and usual practice of judicial proceedings, and has not so far sanctioned such a departure by a lower Court, as to call for an exercise of this Court's power of supervision.

There are here no questions of any dates of invention, of any reissue patent, of any intervening rights, of any licenses to be construed, or of any infringement direct or contributory. There is here no concentration of the industry in any one circuit. The respondent here did not have an early patent soon to expire whose protection it sought to extend by seeking a new patent on minor improvements.

The claims of the two patents here in suit have already been passed upon by the Patent Office, a Special Master, the District Court and the Circuit Court of Appeals. Now this Court is asked to favor the petitioner with still another consideration of these claims. Moreover the specific contentions respecting the application of the rule of the *Bassick* and *Lincoln* cases as well as that of the *Traitel* case<sup>5</sup> have been presented to and fully considered by the judicial tribunals below.

The Clarage Fan Company of Kalamazoo, Michigan, the manufacturer of the infringing apparatus, openly assumed, has conducted and is now conducting the defense of this action (I-175). We include this company as well as the Massachusetts Hair & Felt Company when we use the term petitioner.

### **The Subject-Matter of the Patents.**

Respondent is the owner of two patents, No. 1,846,863 of February 23, 1932 (II-574) and No. 1,989,413 of January 29, 1935 (II-584) granted to it for improvements made by its research engineer, Harold F. Hagen, in respect to a centrifugal fan driven by a constant speed motor and

---

<sup>5</sup> *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259; C.C.A. 2nd.



equipped with adjustable inlet control vanes for varying the spin component of the gases or air entering the fan blades. By changing the position or setting of the control vanes the pressure-volume characteristic of the fan and its output can be varied to meet any change in the demand made on the fan. And the same adjustment of the vanes also produces changes in the horsepower characteristic of the fan which results in a reduction of the power input to the driving motor as the output of the fan is lessened.

The first Hagen patent (No. 1,846,863) discloses what may be termed the generic aspects of Hagen's improvements but only shows how they can be applied to a centrifugal fan of the induced draft type having closed spiral inlet boxes to which gases of combustion are led through a duct system and in which the gases flow between the control vanes to acquire the desired spin before passing through the eye of the fan casing into the spaces between the fan blades. The second Hagen patent (No. 1,989,413) shows the specific application of Hagen's improvement to a centrifugal fan of the forced draft type having an open inlet with control vanes arranged therein to impart the desired spin to the air passing from the atmosphere through the inlet and eye into the spaces between the fan blades.

The only claim of the first patent now in issue\*, claim 2, is sufficiently broad to cover an embodiment of Hagen's improvements with either type of centrifugal fan—induced draft or forced draft. All four claims of the second patent are limited to a specific embodiment of Hagen's improvements with a forced draft fan.

---

\*Because claim 1 of the first Hagen patent was held invalid by the Master, the District Court and the Circuit Court of Appeals, a disclaimer of this claim has been filed in the Patent Office.

### **Facts are Unusually Complex and Technical.**

Because of the difficult technical matters involved the case was referred for trial to a Special Master who spent six full days in hearing the parties, much of which time was devoted to expert testimony relating to aerodynamic and hydraulic considerations and to the prior art patents relied upon by the defense. After nearly a year the Master filed his report. It was prepared with meticulous care and fills more than a hundred pages of the printed record (I-34-136). Even a casual examination shows that it is concerned with more fundamental technical questions and far more involved issues of fact than the petitioner's references to the prior art on pages 3 to 5 of the petition would indicate.

The case does not lend itself to such over-simplified treatment. We realize that a petition and its supporting brief must be "direct and concise" but we also know that petitioner's curtailed statements concerning particular vane shapes and mechanical details are not a fair presentation of the multitude of technical issues which have a distinct bearing on this case. To properly present them would require a full discussion of such subjects as variable-speed control, damper control, throttling, pressure-volume, horsepower and system characteristics, Euler's equation, velocity components and vector diagrams, shock-free entry, tangential admission, shock loss, cavitation, work, and fluid flow in a vortex. These very technical matters, relating solely to issues of fact, were all carefully considered by the Master, the District Court and the Circuit Court of Appeals. It is quite obvious that they embrace far more than mere distinctions between flat vanes, curved vanes and streamlined vanes.

## THE ALLEGED ISSUES.

The two "issues" as presented on page 15 of petitioner's brief are no longer issues because the law controlling them has been definitely settled.

The first alleged issue of "whether an inventor, who has improved one element of an old combination, has any valid enforceable right in a patent in which he claims the old combination with the improved element substituted for the old element of the old combination", was squarely presented to this Court in both the *Bassick* case (*supra*) and in the *Lincoln* case (*supra*).

In the *Bassick* case this Court said:

"The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation are otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this can not be done is shown by numerous cases in this and other federal courts." (298 U. S. 425).

And in the *Lincoln* case this Court reaffirmed the rule when it said:

"The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention." (303 U. S. 549).

No clearer or better determination of petitioner's first alleged issue could be made than was made by this Court in the statements quoted above from the *Bassick* and *Lincoln* cases.

The second alleged issue of "whether a patentee who has patented an invention may later obtain a second patent for

the invention of the first patent with unpatentable additions, merely because the application for the second patent was co-pending with the application for the first patent" is an involved statement of assumed facts which boils down to the simple question of whether or not a patentee can have two patents for the same invention. That would be "double patenting" which has been held from the beginning of the patent law to be entirely improper.

If the second patent is for the same invention as the first patent, it is void, and it is immaterial whether the applications for the two patents were copending or not. This is a self-evident truth and requires the citation of no authority to support it. Reference may be made, nevertheless, to *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 198.

If, however, an inventor makes a generic invention capable of embodiment in two or more specific forms, he may get a first patent for the generic invention and a second patent for a specific embodiment not claimed in the first patent, provided the specific embodiment is a separate invention and the claims of the second patent can not be read on the structure shown in the first patent. Under such circumstances the first patent can not be used to invalidate the second patent if their applications were copending in the Patent Office.\* *The Barbed Wire Patent Case*, 143 U.S. 275, 280.

Thus the alleged "issues" presented by the present petitioner have long been determined and well settled matters of law.

---

\*This proposition is supported by many cases, a few of which are cited *infra* p. 19.

## SUMMARY OF ARGUMENT.

We shall argue that the petition should be denied because:

The Appellate Court fully considered the rule of law stated by this Court in the *Bassick* and *Lincoln* cases, and, having determined as a matter of fact that while Hagen may have improved the design and arrangement of control vanes he nevertheless made *improved combinations*, properly declined to apply the rule of those cases to the facts here;

The petitioner misinterprets the Appellate Court's decision regarding the second Hagen patent and alleges a conflict of decisions which does not exist.

### ARGUMENT.

#### THE RULE OF THE BASSICK AND LINCOLN CASES DOES NOT APPLY HERE.

The patents in both of these cases had to do with apparatus for lubricating metal bearings, particularly those of automobiles. A tubular fitting is permanently connected with each bearing, and every lubricating station has a grease gun with coupler into which grease is forced under pressure from a pump through a hose, whereby, when the coupler is temporarily connected on the fitting, lubricant will be forced into the bearing.

In the *Bassick* case (298 U.S. 415), claims 14 and 15 of the Gullborg patent 1,307,734 were for the combination of a pin fitting (of a type which had already been claimed separately in another patent of Gullborg No. 1,307,733) with *any* grease gun having a bayonet type coupler (421). The respondents sold grease guns which were "of an old unpatented type", and the petitioners contention was that if the respondents furnished such a gun for use with the patented pin fitting they would contributorily infringe claims 14 and 15 of the patent in suit because these claims describe the combination of any grease gun with the patented pin fitting (424). In other words, the petitioner sought to restrain the respondent from selling to filling stations and garages any type of grease gun, even one that was old and unpatented, on the theory that when such a gun was used with any of the millions of patented pin fittings on automobiles, the alleged combination of claims 14 and 15 would be infringed. Obviously that was an unconscionable use of the patent, and the Court so ruled (425).

The *Lincoln* case (303 U.S. 545) presented an equally flagrant state of facts. "The charge is that the petitioner sells fittings such as are described in the respondent's patent which are usable, and intended to be used, in connection with the gun and coupler of the patent" (546). The

patent referred to is the Butler patent No. 1,593,791. Here the respondent attempted to use a combination patent to restrain the petitioner from selling fittings, although the only new improvement Butler had made was in the coupling member. This Court concluded:

“That Butler’s effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claim void.” (303 U. S. 552).

It might be asserted, we think, that the *Bassick* and *Lincoln* cases apply only to instances in which the patentee endeavors to embrace within his patent more than in equity and good conscience he is entitled to do. Here the respondent is making no such unconscionable attempt and on that score does not deserve the application of the rule of the *Bassick* and *Lincoln* cases. But aside from any question of improper attempt, the rule does not apply here at all.

Let us look at the particular rule stated by this Court in deciding those cases. The rule is fully expressed in the *Bassick* case as follows:

“The question then is whether, by this method, the patentee, by improving one element of an old combination *whose construction and operation are otherwise unchanged*, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element.” (298 U.S. 425).

We have italicized a portion of the above quotation which we believe definitely indicates wherein the present case differs from the *Bassick* case. Similarly, we quote below a statement from the *Lincoln* case, also with a portion italicized to indicate a similar distinction between the *Lincoln* case and the present one.

“The mere aggregation of a number of old parts or elements which, in the aggregation, *perform or produce no new or different function or operation than that theretofore performed or produced by them*, is not patentable invention.” (303 U.S. 549).

The particular point involved here is that Hagen’s claims are not for old combinations whose construction and operation are unchanged by his improvements.

That the Court of Appeals fully appreciated the situation is clear from its final statement after reconsideration of the case. The Court said:

“The reason we do not consider these cases to be in point is that Hagen, unlike the patentees in the *Lincoln* and *Bassick* cases, made no attempt to cover in his patent, which is a combination one, all of the separate parts of the combination including those which were unpatented and old in the art. That is, he did not attempt by his patent to prevent others from using any form of vane controlled centrifugal fan, but attempted only to prevent others from using such a fan, with inlet vanes substantially similar to his. As pointed out in the original opinion the question thus presented is whether or not the new element which he added to the old combination, i. e., the new form and arrangement of the vanes, caused the combination to produce a new and useful result which was not merely the ‘aggregate of several results, each the complete product of one of the combined elements.’ In our original opinion we answered this question in the affirmative with respect to the second patent. The same reasoning applies with at least equal force to the first one and compels a similar answer with respect to it.” (III-828).

Thus the present case is clearly outside the rule of the *Bassick* and *Lincoln* cases.



### HAGEN MADE IMPROVED COMBINATIONS.

The "findings" quoted by petitioner on pages 17 and 18 of its brief,\* when separated from their context in the Master's Report, appear to support the contention that all Hagen improved was the design and arrangement of vanes. Even the petitioner does not question that Hagen did that much. But there are ample findings that Hagen's patentable improvements were something more, namely improved combinations.

The Master reported:

"In the present case, so far as appears, Hagen was the first to develop a constant speed fan wherein the output is controlled by supplying a variable spin to the entering air by means of adjustable vanes at the inlet. His vane controlled fan constitutes a highly useful and valuable contribution to the fan art, has gone into wide use, and has supplied a very real need." (I-106).

"Hagen made the first vane control fan after long experimentation, and it constituted a distinct and valuable contribution to the art. His commercial success was followed by appropriation by the defendant of the essential features of his fan as set forth in claim 2. Hagen is entitled to great credit." (I-112).

"It is true that all Hagen did was to provide adjustment over substantially the entire range, with a design and arrangement of vanes that gave definite, predictable and controlled flow throughout the range, under conditions which reduced throttling or eddy losses to a minimum. True, also, he was applying a known prin-

---

\* The quotation on page 19 of petitioner's brief was ordered withdrawn by the Court of Appeals and the text appearing at III-828 was substituted.

ciple. But he took this principle and, by dint of extensive experimentation, for the first time produced a highly successful and useful vane controlled fan, embodying an arrangement, as set forth in claim 2, which was new and which was considered sufficiently important to have been adopted by defendant, following Hagen's development." (I-113-114).

The Circuit Court of Appeals said:

"Hagen's contribution, then, was of a mechanism for controlling the output of a centrifugal fan by vanes, not down to a useless capacity of zero, but only to a minimum capacity. This had practical value and it achieved commercial success. It approximated, if it did not equal, the range of control possible by altering the speed of the impeller, as had been done with efficiency by steam turbines but which could not be efficiently done with the usual type of electric motor available for fan drive after steam turbines had become unavailable for the purpose, and it accomplished this range of control almost entirely by power-saving spin and with a minimum of power-wasting throttling.

"It does not seem to us that it would have occurred to a mechanic or designer skilled in the art either to disregard increasing shock-loss\* by radically increasing the spin of the entering air or to construct vanes of cylindrical contour for the purpose of providing passages between them 'of substantially uniform cross-section as the vanes are moved to closed position', so that control to minimum capacity by spin rather than by throttling would result. Thus the finding of patentable

\*According to testimony of the experts, and as pointed out in the report (I-53, 54) "shock-loss" is the loss of energy at the rotating fan blades as a consequence of the variation in direction of flow effected by the control vanes.

invention made by the master and confirmed and adopted by the court must stand." (III-812).

"At any rate, a finding of invalidity for lack of patentable invention can, under the findings quoted above, be based only on the ground that the mechanism described in this patent is merely an aggregation of old parts, and on that ground the finding cannot be sustained. The reason for this is that the Hagen mechanism for applying vane control to a forced draft fan, although it combined old parts, combined them in such a way as to produce a new and useful result, *i. e.* more predictable and better control over a wide range, such control being almost wholly by spin and almost wholly without throttling, and this new and useful result was the 'product of the combination, and not a mere aggregate of several results, each the complete product of one of the combined elements.' (Authorities). Thus the combination is patentable." (III-815).

The foregoing findings are fully justified by the facts. Among such facts we refer to petitioner's own statements in technical bulletins. Its infringing apparatus is "something entirely new in principle", is "revolutionary, and something which engineers generally have not heard of before", and the results it attains "are little short of startling" (I-68). In one of its bulletins, petitioner stated: "In this connection it should be noted that the Vortex Control operates as a *part of the fan*" (Underscoring theirs, not ours.) (II-609). And in another bulletin petitioner repeats, "Vortex Control operates as a part of the fan" (II-621).

On the back of this same bulletin, the petitioner makes comparative equations between "The Old Way" and "The New Way". Note that in "The New Way" equation petitioner illustrates the *combination* of the fan with the vane or Vortex control and the constant speed motor (II-623).

Hagen's inventions were not directed to any one element but to *improved combinations* of elements which depend upon one another for the joint and cooperative action of the assemblies as a whole. Accordingly the findings of facts made by the Appellate Court were fully warranted and its refusal to apply the rule of the *Bassick* and *Lincoln* cases to the facts here was entirely proper.

On this ground the petitioner has not presented any sufficient reasons for the grant of the petition.

**PETITIONER'S ALLEGATIONS OF CONFLICT OF DECISIONS  
NOT SUPPORTED BY CASES.**

In point 3, page 25, of its brief, petitioner asserts that the "Circuit Court of Appeals for the First Circuit has held that an inventor who has obtained a patent for his invention may obtain a second and later patent, relying upon the same inventive concept, by merely making unpatentable additions to the invention of his first patent, merely because the applications for the patents were copending."

We question if any such construction should be placed upon the Court of Appeals decision.

**The Decision of the Circuit Court of Appeals.**

What the Court said was:

"On the question of anticipation by Hagen's first patent the defendant, citing *Mahn v. Harwood*, 112 U. S. 354; *Toledo Scale Co. v. Computing Scale Co.*, 9 F. (2d) 823; and others of similar import, argues that since the issuance of a patent operates as a dedication to the public of all that might have been claimed therein but was not, Hagen's first patent, in which he failed to claim his apparatus for a forced draft fan, operates to invalidate his second one. The argument is beside the point because Hagen applied for his second patent before his first patent was issued. Both of his applications were co-pending in the patent office from October 31, 1929, to February 23, 1932. Under these circumstances the rule is that when the claims are for separate inventions, as they are here, one being for an induced draft fan and the other being for a forced draft one, 'The issuance of the first patent does not abandon the unclaimed matter in its disclosure, the pendency of the second application rebutting any such inference,' and

this is so even though the claims of the second patent do not 'embody a patentable advance over the earlier disclosure.' *Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co.*, 22 F. (2d) 259, 260, 261. See also *The Barbed Wire Patent, supra*, 280." (III-815, 816).

As we interpret the foregoing statement, the Court below first points out that, contrary to petitioner's earlier contentions, the fact that Hagen had failed to claim in his first patent the specific embodiment of his improvements in a forced draft fan did not dedicate that embodiment to the public nor abandon it. Such alleged dedication or abandonment was completely contradicted by the fact that before his first patent issued Hagen's application for his second patent was on file in the Patent Office. This is what the court particularly pointed out when it said:

"Under these circumstances the rule is that when the claims are for separate inventions, as they are here, one being for an induced draft fan and the other for a forced draft one, 'The issuance of the first patent does not abandon the unclaimed matter in its disclosure, the pendency of the second application rebutting any such inference', . . .".

The Court of Appeals fully appreciated that in order for the rule to apply, the claims of the two patents must be for *separate inventions*".\* Two patents for the *same* invention cannot be granted, regardless of whether their applications are copending or not. The Court of Appeals was en-

---

\* That the claims of the second patent do call for a different combination from that disclosed in the first Hagen patent can readily be determined by attempting to read the claims on the induced draft fan structure. Not a single claim of the second patent can be read on the apparatus shown in the first patent. That fact alone shows that the patents were granted for separate inventions.

tirely clear on that point and stated what has long been regarded as settled law.

### **"Patentable Advance".**

The Court went on to say that the same rule is followed, "even though the claims of the second patent do not 'embody a patentable advance over the earlier disclosure'", citing the *Traitel* case as the source of its quotations. What the Court of Appeals meant in this case, just as did the Court of Appeals for the Second Circuit in the *Traitel* case, is that where an inventor has a generic concept capable of reduction to practice in different embodiments, he may disclose his invention generically or may only show its application to one specific embodiment in one patent, and then disclose and claim another specific embodiment in another patent. Because both specific embodiments, though different, grew out of the original generic concept one embodiment is not deemed to be a patentable advance over the other. Hence the claims of the second patent may not "embody a patentable advance over the earlier disclosure", but if they are for a separate invention, "as they are here", then the first patent cannot be employed to invalidate the second.

### **The Traitel Case.**

That is precisely what was decided in the *Traitel* case. The Court likewise held: that the copendency of the applications of the two patents involved there rebutted any inference of abandonment of the unclaimed matter in the disclosure of the first patent; that "It is familiar law that a species claim may be good invention, notwithstanding that the genus is already in the public demesne, which implies that it is a separate invention,"; and that the "earlier patent was not part of the prior art, and it is not necessary

to the validity of the claims in suit (second patent) that they should embody a patentable advance over the earlier disclosure". But the Court in the *Traitel* case also very pertinently said:

"Therefore all we have to do in the case at bar is to decide whether the claims in suit are for a *separate invention* from the original *claims* allowed upon the first application." [Italics ours.]

### No Conflict of Authority.

Petitioner contends that there is a "definite clash of authority" between the *Traitel* case and some fourteen cases cited on page 26 of its brief. Petitioner treats the *Traitel* case as if it were a single isolated case set against "a large body of authority" contrary thereto. The petitioner is wrong on two points. First, the *Traitel* case is but one of a long line of authorities in this Court and the several Circuit Courts of Appeals. Second, these cases present no conflict with those cited by Petitioner.

The following is a brief list taken from the multitude of cases supporting and following the *Traitel* case:

*Suffolk Mfg. Co. v. Hayden*, 3 Wall. 315, 318.

*Cantrell v. Wallick*, 117 U.S. 689, 694.

*The Barbed Wire Patent Case*, 143 U.S. 275, 280.

*Anderson v. Collins*, 122 F. 451, 458; (C.C.A. 8).

*Century Electric Co. v. Westinghouse*, 191 F. 350, 352; (C.C.A. 8).

*Sandy MacGregor Co. v. Vaco Grip Co.*, 2 F. (2d) 655, 656; (C.C.A. 6).

*Skinner Bros. Belting Co. v. Oil Well Imp. Co.*, 54 F. (2d) 896, 899; (C.C.A. 10).

*City of Milwaukee v. Activated Sludge Inc.*, 69 F. (2d) 577, 587; (C.C.A. 7).



*General Tire & Rubber Co., v. Fisk Rubber Corp.*,  
104 F. (2d) 740, 745; (C.C.A. 6).

The foregoing decisions do not conflict in any way with the fourteen cases cited by petitioner. *Oates v. Camp* has nothing whatever to do with the questions here presented. Twelve of the cases were in the Court of Customs and Patent Appeals on appeals from the Patent Office. One case, *Bissell v. Coc*, is a decision by the Court of Appeals for the District of Columbia under R. S. 4915, equivalent to an appeal from the Patent Office.

A review of the thirteen cases does not support petitioner's contentions regarding conflict of authority. In every case it is quite clear that the second application was not for a *separate* invention from the applicant's first patent. In the footnote below we quote pertinent excerpts from a number of these cases.\*

---

\*"We think it clear that the application here in issue does not claim a separate invention from that claimed in the issued patent, but only claims an obvious use of the composition there patented. *In re Byck*, 48 F. (2d) 665, 666.

"The appellant, having disclosed or claimed no matter patentably distinct from that claimed in his existing patent, cannot have a second patent upon the same invention. . . ." *In re Peiler*, 56 F. (2d) 878, 880.

"We agree, however, with the Patent Office tribunals that appellant is here 'claiming nothing more than the same invention in substance as is claimed in the patent,' ". *In re Neuberth*, 82 F. (2d) 718, 720.

"We construe this to be a holding that the compound claimed in appealed claim 56 is, in substance, the same as that of the composition claimed in claim 6 of the patent, and nothing has been presented before us which would lead us to feel justified in holding otherwise." *In re James*, 83 F. (2d) 313, 314.

"For the reasons hereinbefore stated, we think the involved claims embrace only the same invention as is embraced in the claims of appellant's parent application, . . ." *In re Seebach*, 88 F. (2d) 722, 724.

"The facts in that case [*Traitel v. Hungerford*] differ from those in the case at bar." *In re Land*, 109 F. (2d) 246, 250.

". . . In other words, it seems to us that this is another way of

These quotations show clearly that in every one of the cases before the court the applicant was not trying to claim *separate* invention, but was actually trying to get a separate patent for the *same* invention covered by a prior patent. This attempted extension of patent rights was properly condemned by the Court.

But the Court of Customs and Patent Appeals has, when the facts warranted, applied exactly the same rule as that stated in the *Traitel Marble* case. The following is a brief list of cases decided by the Court of Customs and Patent Appeals in which it is clearly stated that the first patent may not be cited against the second patent or application when the second is for a *separate* invention from the first.

*In re Carlton*, 77 F. (2d) 363.

*In re Calvert*, 97 F. (2d) 638.

*In re Davis et al.*, 123 F. (2d) 651.

Furthermore, this rule has been followed by the Board of Appeals of the Patent Office, as indicated by the following representative cases:

*Ex parte Kyrides*, 48 USPQ 337.

*Ex parte McCarthy*, 50 USPQ 480.

*Ex parte Cohen*, 52 USPQ 189.

Conversely, this Court and the Circuit Courts of Appeals have, in infringement suits, invalidated a second patent when it attempted to cover the *same* invention as that claimed in a prior patent of the same patentee, even though the applications were copending in the Patent Office.

*Busell v. Stevens*, 137 U.S. 423.

*Underwood v. Gerber*, 149 U.S. 224.

---

ing that appellant would have two patents for the same invention and that, therefore, double patenting would exist." *In re Land*, 77 F. (2d) 251, 252.

*Thomson-Houston Co. v. Jeffrey Mfg. Co.*, 101 F. 121 (C.C.A. 6).

*Lion Fastener, Inc. v. Hookless Fastener Co.*, 72 F. (2d) 985 (C.C.A. 3).

These cases relate to the familiar doctrine of "double patenting". They are identical in import with the cases cited on page 26 of petitioner's brief.

Thus, there is a clear uniformity of decision in the cases of the Circuit Courts of Appeals in infringement cases, and the Court of Customs and Patent Appeals in appeals from the Patent Office.\* All of the courts uniformly hold that whether the applications were copending or not, the inventor may not have two patents for the *same* invention, and all of the courts hold with equal uniformity that in the case of copending applications the inventor is entitled to a second patent if it is for a *separate* invention from the first.

There is no conflict of authority here. The Circuit Court of Appeals in this case found as a *fact* that the two Hagen patents are for *separate* inventions and followed a rule of law which was established by this Court in the *Barbed Wire Patent Case* and has been consistently followed by all Courts ever since.

---

\*As a matter of statistics, the greater proportion of cases in the Court of Customs and Patent Appeals refuse the claims of the second application, while the greater proportion of Circuit Courts of Appeals cases hold the second patent valid. The reason is not far to seek. The CCPA takes only those cases which have already been rejected by the Patent Office Examiners and Board of Appeals, but the courts that hear infringement cases work only with patents that have passed through the Patent Office sieve. The fact that there are so few "double patenting" cases in infringement suits shows that the sieve works well. There is no "clash of authority" here.

### **Duration of Patent Terms Not Pertinent Here.**

Petitioner also seeks to make a point of the fact that since Hagen's first patent will expire February 23, 1949, and Hagen's second patent will expire January 29, 1952, Hagen will therefore have exclusive rights under the second patent for three years longer than under the first patent. This is nothing unusual and only means that after the first Hagen patent expires and the public is free to use the invention disclosed, the respondent will continue to have exclusive rights under the second patent to the specific application of the improvements with a forced draft fan.

If it should be felt that a patentee ought not to have the benefit of any protection under a second patent after a first patent has expired, it should be pointed out that this is a matter fixed by law. The patent statutes require each patent to issue for a fixed term of seventeen years. In some countries, notably Great Britain (and also France before the war) provision is made for so-called "Patents of Addition". An inventor there who has a patent for a generic invention and later makes an improvement thereon may get a patent of addition for the improvement. This patent of addition expires on the same date the first patent expires. If such a law were in effect in this country and if Hagen had taken his second patent as a patent of addition, no assertions concerning "extension of monopoly" could be made.

Such is not the law here, however, and Congress has not seen fit to make any provision for patents of addition. Under our statutes a patentee is forced to take his patent for the full term of seventeen years, even though he might be willing, if the law so provided, to accept a second patent for a shorter term. Under these circumstances, petitioner's argument on this point should be directed to Congress and not to the courts.

CONCLUSION.

“A review on writ of certiorari is not a matter of right, but of sound judicial discretion, and will be granted only where there are special and important reasons therefor.” (Rule 38 of this Court.)

The petition sets forth no special and important reasons justifying its grant and we therefore pray that it be denied.

Respectfully submitted,

B. F. STURTEVANT COMPANY,  
*by* HARRY DEXTER PECK,  
 MELVIN R. JENNEY,  
*Attorneys for Respondent.*

